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65 FR 54604, \*

## FEDERAL REGISTER

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Rules and Regulations

DEPARTMENT OF COMMERCE (DOC)

United States Patent and Trademark Office (USPTO)

**37 CFR Parts 1, 3, 5, and 10**

[Docket No.: 980826226-0202-03]

**RIN 0651-AA98**

### **Changes To Implement the Patent Business Goals**

Part II

65 FR 54604

**DATE:** Friday, September 8, 2000

**ACTION:** Final rule.

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**[\*54604]**

**SUMMARY:** The United States Patent and Trademark Office (Office) has established business goals for the organizations reporting to the Commissioner for Patents (Patent Business Goals). The focus of the Patent Business Goals is to increase the level of service to the public by raising the efficiency and effectiveness of the Office's business processes. In furtherance of the Patent Business Goals, the Office is changing the rules of practice to eliminate unnecessary formal requirements, streamline the patent application process, and simplify and clarify the provisions of the rules of practice.

applies to plant patents in color, and that the fee in § 1.19(a)(3) applies to patents (other than plant patents) containing a color drawing.

Former sections 1.19(b)(1) and (b)(2) are divided into three sections (§§ 1.19(b)(1), 1.19(b)(2), and 1.19(b)(3)), with the former provisions of §§ 1.19(b)(3) and 1.19(b)(4) being redesignated as §§ 1.19(b)(4) and 1.19(b)(5). Section 1.19(b)(1) refers to the application as filed. Section 1.19(b)(2) is limited to charges for the paper portion of the complete patent application file wrapper, namely: \$ 200 for copies of the first 400 pages of a patent application file wrapper and contents and \$ 40 for each additional one hundred pages, or fraction thereof. Section 1.19(b)(3) provides for a charge of \$ 55 for a copy of a compact disc in a patent application file wrapper, and \$ 15 for each additional compact disc when it is part of the same order. The submission of application information on compact disc is now provided for in §§ 1.52(e), 1.96 and 1.821 *et seq.*

Section 1.19(g) is removed and reserved. The practice of comparing and certifying documents not produced by the Office is being eliminated. The Office considers it appropriate to certify copies of documents only when the copy of the document has been prepared by the Office.

Section 1.19(h) is also removed and reserved. The \$ 25 fee under § 1.19(h) for obtaining a corrected or duplicate filing receipt is no longer necessary as the Office is now performing that service without charge. Consequently, where there is an error in a filing receipt, applicants need no longer provide a showing that the error was due to Office mistake or pay a \$ 25 fee for the corrected receipt. *See Changes In Practice In Supplying Certified Copies And Filing Receipts*, 1199 Off. Gaz. Pat. Office 38 (June 10, 1997).

*Comment 8:* One comment stated that the proposed fee of \$ 250 for copies of certified and uncertified patent-related file wrappers and contents of 400 or fewer pages was excessive, and that \$ 100 for the first 400 pages would be more reasonable, if it costs 25 cents a page for copying. In addition, the comment stated that there should be no reason why a flat page charge cannot be used; that with the proposed rule, the number of pages would have to be counted to see whether the initial 400-page limit has been reached, and that it should not be a burden to determine the number of pages that have been copied.

*Response:* The comment is adopted to the extent that the cost for the first 400 pages has been reduced to \$ 200. Much of the cost per page for copying a given application depends upon the difficulty in obtaining the application, the time required putting the papers in condition for copying and returning those same papers to the file in their original condition, and the number of pages being fed instead of copied as a single sheet. A fee of \$ 200 has been determined to be the appropriate price for locating, preparing, copying and mailing the average application. As to charging based upon the number of pages, this suggestion has been carefully considered but has not been adopted. In order to improve efficiency, the Office needs to have a procedure which will generally require the least communications between the requester and the Office. If a flat \$ 200 fee is charged for file wrappers with fewer than 400 pages, then most requesters of file wrappers can pay the set fee and receive their order without any additional communication with the Office. When the file wrapper is larger than 400 pages, then the Office either will have to receive a deposit account authorization for any fees due which can be debited or request the additional money from the requester. Since many requesters do not have deposit accounts and others will be reluctant to allow any charge to be made to their deposit account or credit card, having a system where the Office charges a set fee for most orders and possibly contacting the requester to obtain additional fees when the order is very large will assist requesters in minimizing the risk of unexpectedly large charges.

*Section 1.22:* Section 1.22(b) is amended to change "should" to "must" because the Office needs fees to be submitted in such a manner that it is clear for which purpose the fees are

paid. Section 1.22(b) is also amended to provide that the Office may return fees that are not itemized as required by § 1.22(b), and that the provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to § 1.22.

Section 1.22 was proposed to be amended to add §§ 1.22(c)(1) and (2) to define by rule when a fee had been paid, such as when payment is made by authorization to charge a deposit account, or by submission of a check. An effect of the rule change would have been to change the treatment for refund purposes of payments made by authorization to charge a deposit account. The proposed amendment will not be made as amendment is unnecessary in view of payment receipt dates already being governed by other rules (e.g., §§ 1.6, 1.8 and 1.10). Notwithstanding the lack of amendment to § 1.22, the Office is changing in one aspect its treatment of authorizations to charge deposit accounts for refund purposes, which aspect is not explicitly governed by other rules. The Office will no longer treat authorizations to charge a deposit account as being received by the Office as of the date that the deposit account is actually debited for purposes of refund payments under §§ 1.26 and 1.28. As of the effective date of this final rule, payment by authorization to charge a deposit account will be treated for refund purposes the same as payments by other means (e.g., check or credit card charge authorization), with each being treated as paid (for refund purposes) on the date of receipt in the Office as defined by § 1.6 (Example 1). The advantage of using a certificate of mailing under § 1.8 for timely reply to an Office action, while using the date of receipt by the Office (§ 1.6) of the payment for refund purposes, will be retained (Example 2). The MPEP will be revised to contain the substance of the formerly proposed amendment to § 1.22 (c).

*Example 1:* Payment of a large entity basic filing fee by authorization to charge a deposit account is hand-carried to the Office on October 2, 2000. The deposit account is debited by the Office on February 2, 2001. A request for refund of a portion of the filing fee, based on a request for small entity status, is hand-carried to the Office on March 30, 2001. Under prior practice, the request for refund would be granted as timely submitted within two months of debiting of the deposit account. Under the new practice, the request for refund would be denied as untimely made. Applicant would, however, under the amended rule, have three months (rather [**\*54608**] than two) from the October 2, 2000 payment date to submit the refund request.

*Example 2:* A Notice to File Missing Parts of Application was mailed on November 10, 2000, requiring a large entity basic filing fee with the standard period for reply of two months. A check for payment of the large entity basic filing fee is mailed with a § 1.8 certificate of mailing date of January 10, 2001, and is actually received in the Office on January 15, 2001. Under prior and current practice, the January 10, 2001 reply to the November 10, 2000 Notice to File Missing Parts of Application, which was received in the Office on January 15, 2001, is a timely reply without the need for an extension of time under § 1.136(a), and the (new) three-month period for submission of a request for refund based on small entity status under amended § 1.28(a) would expire on April 16, 2001 (April 15, 2001 being a Sunday). For a fee payment made by authorization to charge a deposit account, the payment is also timely and results in the same expiration for the refund period. For express mail fee payments under § 1.10, the express mail date is the receipt date for the payment and calculating the three month refund period and not the actual date of receipt of the payment in the Office.

*Comment 9:* One comment requested that explicit guidance be provided in the MPEP as to what would constitute a sufficiently clear statement of the purpose for which fees are being paid under § 1.22(b). In particular, the example was raised as to whether a statement that "filing fees were being paid" would be sufficient if the fees being paid included both a basic filing fee and an additional independent claim fee.

*Response:* The comment is adopted. The MPEP will be revised to provide examples that will

clarify what constitutes a sufficiently clear statement. The intent of the amendment is to encourage a better explanation by applicants so that Office employees can properly account for the payments being made by applicants and not to find ways to hold a statement deficient. Specifically, the reference to filing fees would be sufficient to cover filing fees of all different types of applications and all types of claims fees.

*Comment 10:* One comment opposed the addition of § 1.22(c), as the addition was confusing, particularly in regard to §§ 1.8 and 1.10 payments, and the addition was not necessary to support the proposed amendment to § 1.26(b) for a two-year period for refunds from a date certain.

*Response:* The comment is adopted and the proposed addition of § 1.22(c) will not be made. The amendment is not in fact necessary to define when a fee has been paid, in view of the change in practice regarding treatment of deposit account practices, *supra*, §§ 1.8, or § 1.10, and the actual date of receipt (in the absence of §§ 1.8 or 1.10 being utilized). The MPEP will be modified to better clarify date of payments, particularly as refund time periods are impacted.

*Section 1.25:* Section 1.25(b) is amended to provide that an authorization to charge fees under § 1.16 (which relates to national application filing fees) in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under § 1.492 (which relates to national stage fees). There are many instances in which papers filed for the purpose of entering the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 include an authorization to charge fees under § 1.16 (rather than fees under § 1.492) which relates to national applications under 35 U.S.C. 111. In such instances, the Office treats the authorization as an authorization to charge fees under § 1.492 since: (1) timely payment of the appropriate national fee under § 1.492 is necessary to avoid abandonment of the application as to the United States; and (2) the basic filing fee under § 1.16 is not applicable to such papers or applications. Therefore, the Office is changing § 1.25(b) to place persons filing papers to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 on notice as to how an authorization to charge fees under § 1.16 will be treated.

Section 1.25(b) is also amended to provide that an authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b), and to bring together the two sentences relating to sufficient funds.

*Comment 11:* See comment for § 1.311.

*Section 1.26:* The Office is amending the rules of practice to provide that all requests for refund **must** be filed within specified time periods. The rules of practice do not (other than in the situation in which a request for refund is based upon subsequent entitlement to small entity status) set any time period (other than "a reasonable time") within which a request for refund **must** be filed. In the absence of such a time period, Office fee record keeping systems and business planning **must** account for the possibility that a request for refund may be filed at any time, including many years after payment of the fee at issue.

The new two year limit for requesting refunds under § 1.26 will be applied to any fee paid regardless of when it was paid. The two year time period for requesting a refund will end two years and sixty days from the date of publication in the **Federal Register for fees paid prior to sixty days from the date of publication in the Federal Register, or two years from payment of the fee for fees paid on or after sixty days from the date of publication in the Federal Register .**

**It is a severe burden on the Office to treat a request for refund filed years after payment of the fee at issue. Since Office fee record keeping systems change over time, the Office must check any system on which fees for the application, patent, or**